

REMARKS

Applicant hereby provisionally elects the claims 1-5, 10-11 and 16-21 identified under Group I. This election is made with traverse relative to the restriction of the claims of Group I from the claims of Group II (*i.e.*, claims 6-9 and 12-15), which is improper for the reasons presented below. Applicant also provisionally elects Species 1 (*i.e.*, claims 1-5) with traverse. Applicant submits that no valid reason for the restriction of Species 1, 3 (*i.e.*, claims 10-11) and 4 (*i.e.*, claims 16-21) relative to each other has been presented and thus claims 1-5, 10-11 and 16-21 should be examined together as is discussed in detail below.

Applicant respectfully traverses the restrictions presented in the Office Action because the Office Action fails to provide sufficient support for the restrictions.

Regarding the restriction of Groups I (*i.e.*, 1-5, 10-11 and 16-21) and II (*i.e.*, claims 6-9 and 12-15), the Office Action simply concludes that the device as claimed can be made by another materially different process. *See, e.g.*, M.P.E.P. § 806.05(f). Specifically, the Office Action states that the product as claimed can be formed by a process that does not require an implanting step or doping step. The Office Action, however, has not presented any evidence to support this conclusion since the Office Action has not provided an example of how else Applicant's PI region could be formed. Moreover, claims 6-9 are directed to a process of using a device, not a process of making a device. *See, e.g.*, M.P.E.P. § 806.05(h) ("A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. The burden is on the examiner to provide an example"). As the Office Action has not provided such an example, the restriction of claims 6-9 relative to the claims identified as being part of Group I is clearly erroneous and cannot be maintained.

Regarding the restriction of Species, the Office Action simply concludes that Species 1-4 are independent or distinct without providing reasoning to support this conclusion as required. *See, e.g.*, M.P.E.P. § 808.01 ("The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely

stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.”). In this instance the Office Action improperly concludes that species 1-4 are independent or distinct based on the assertion that Species 1-4 recite mutually exclusive characteristics. Specifically, the Office Action has not provided any analysis regarding how or why the Office Action has concluded that Species 1-4 are independent (*i.e.*, that these species are not connected in any of design, operation, or effect). *See, e.g.*, M.P.E.P. § 806.04(b). Species are not independent or distinct simply because they recite mutually exclusive characteristics. According to M.P.E.P. § 806.05(j), related inventions are “distinct if (A) the inventions *as claimed* do not overlap in scope, *i.e.*, are mutually exclusive; (B) the inventions *as claimed* are not obvious variants; and (C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect.” In this instance the Office Action has not provided any indication that Species 1-4 are not capable of use together or that these species can have a materially different design, mode of operation, function, or effect as required to show that these species are distinct. Thus, the restriction of Species 1-4 relative to each other is improper and cannot be maintained.

Moreover, M.P.E.P. § 806.05(j) further requires that “reasons for insisting on restriction are necessary, *i.e.*, separate classification, status in the art, or field of search.” Regarding Species 1 (*i.e.*, claims 1-5), 3 (*i.e.*, claims 10-11) and 4 (*i.e.*, claims 16-21), page 2 of the Office Action indicates that these claims are classified in the same class and in the same subclass. The Office Action further fails to show a recognition of separate inventive effort by the inventors in regard to Species 1, 3 and 4 or that it is necessary to search for one of these Species in a manner that is not likely to result in finding art pertinent to the other Species. *See, e.g.*, M.P.E.P. § 808.02. Thus, the Office Action does not provide reasons for insisting on restriction of Species 1, 3 and 4 relative to each other. Applicant notes that claim 21 depends from claim 2 and thus should be part of Species 1, not Species 4.

Applicant has added new claims 22-24. Support for new claims 22-24 can be found throughout Applicant’s disclosure including, for example, in Figure 1. Applicant submits that

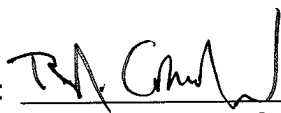
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claims 22-24 should be examined with provisionally elected claims 1-5 because these claims are directed to related inventions and because claims 1 and 22 do not recite mutually exclusive characteristics. *See, e.g.*, M.P.E.P. § 806.05(j).

Accordingly, Applicants respectfully requests that the Examiner withdraw the present restriction requirement(s) for examination of all the claims.

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